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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,698	02/27/2004	Craig David Carroll		9297

7590 08/03/2006

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EXAMINER

WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/789,698		CARROLL, CRAIG DAVID	
	Examiner		Art Unit	
	David J. Walczak		3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 and 24-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I, Species II in the reply filed on 4/11/06 is acknowledged. The Applicant contends that all of claims 1-36 read on the elected group/species, however, Group I includes only claims 1-23 (as the restriction requirement mailed 11/18/05) and claims 20-22 do not read on the elected embodiment (claim 20 reads on Species IV, claim 21 reads on Species III and claim 22 reads on Species VI). Accordingly, claims 20-22 and 24-36 are hereby withdrawn from further consideration and claims 1-19 and 23 will be examined herein. It is further noted that since the amendments to claims filed 12/5/05 and 1/11/06 have not been entered. The claims filed on 7/1/04 are the currently pending claims.

Abstract

The abstract of the disclosure is objected to because phrases that can be implied, such as "The present invention provides" should not be present therein. Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities: On page 9, line 3, "pushes" should be --pushed-- and the verbiage at the bottom of page 15 (in reference to the claims) should be deleted. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

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of the following is required: The language in claims 6 and 7 does not have antecedent basis in the Detailed Description of the Invention.

Claim Rejections - 35 USC § 112

Claims 8-20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 8, an antecedent basis for "the leading section" and "the cartridge" should be defined. In regard to claim 9, an antecedent basis for "the tip" and "the opening" (line 5) should be defined. In regard to claim 23, an antecedent basis for "the second leading section" should be defined. In regard to claim 12, it is unclear as to whether or not the cartridge is intended to be part of the claimed combination. For example, the language of claim 9 indicates that a cartridge is not being claimed, however, the language of claim 12 seems to indicate that the cartridge is claimed. Should the Applicant intend to claim the cartridge, an antecedent basis for the cartridge should be defined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 9 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, 19, 23 and 46 of copending Application No. 10/864,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 15, 19, 23 and 46 anticipate claim 9 and anticipation is the epitome of obviousness.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-11, 13-17, 19 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis, Jr. et al. (hereinafter Lewis). In regard to claims 1, 9, 17 and 19,

Lewis discloses a retractable writing tool comprised of front and rear barrels, a tip 102, a feeder 1804 and a silicone valve 300 having a round face 704 with a concave shape profile (a portion of the the inner side surface of the valve has a concave profile) and a slit 602 wherein the valve seals the tip when the tip is in a retracted position. In regard to claims 2, 3 and 16, the valve is formed from a thermoplastic elastomer. In regard to claim 6, the inner circumference of the front barrel is "about the same" as the outer circumference of the valve. In regard to claim 7, the front of the valve is separated from the inner circumference of the front barrel by an open space. In regard to claims 8 and 23, the back of the valve has a hole that seals around the cartridge (at 702). In regard to claims 10 and 11, the valve has a cavity 1208 that engages with a tab 14 on the barrel. In regard to claim 13, a tension device 1400 closes the slit. In regard to claims 14 and 15, the tensioning device is considerer to be both a ring (as per element 1404) and an "elastic band".

Claims 1-3, 6-11, 13-17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Waldinger et al. (hereinafter Waldinger). In regard to claims 1, 9, 17 and 19, Waldinger discloses a retractable writing tool comprised of front and rear barrels, a tip 34, a feeder, and a silicone valve 48 (see column 2, line 52) having a round face 38 with a concave shape profile (a portion of the the inner side surface of the valve has a concave profile) and a slit 52 wherein the valve seals the tip when the tip is in a retracted position. In regard to claims 2, 3 and 16, the valve is formed from a thermoplastic elastomer. In regard to claim 6, the inner circumference of the front barrel is "about the same" as the outer circumference of the valve. In regard to claim 7, the

front of the valve is separated from the inner circumference of the front barrel by an open space. In regard to claims 8 and 23, the back of the valve has a hole that seals around the cartridge (at 28). In regard to claims 10 and 11, the valve has a cavity that engages with a tab 22 on the barrel. In regard to claim 13, a tension device 22 closes the slit. In regard to claims 14 and 15, the tensioning device is considered to be both a ring and an "elastic band".

Claims 1, 6, 9, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Blaustein et al. (hereinafter Blaustein). In regard to claims 1, 9, 17 and 19, Blaustein discloses a retractable writing tool comprised of front and rear barrels, a tip 31, a feeder, and a silicone valve 40 (see column 4, line 40) having a round face with a concave shape profile) and a slit 44 wherein the valve seals the tip when the tip is in a retracted position. In regard to claim 6, the inner circumference of the front barrel is "about the same" as the outer circumference of the valve.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldinger. Although the Waldinger reference does not disclose the specifically claimed materials, the Examiner takes official notice that such materials are commonly employed when making such elastic elements. Accordingly, it is the Examiner's

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position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the valve in the Waldinger device can be made with any suitable material, including those claimed, without effecting the overall operation of the device.

Claims 2-5, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaustein. Although the Blaustein reference does not disclose the specifically claimed materials, the Examiner takes official notice that such materials are commonly employed when making such elastic elements. Accordingly, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the valve in the Waldinger device can be made with any suitable material, including those claimed, without effecting the overall operation of the device.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldinger in view of Zepell. Although the cartridge in the Waldinger reference does not have a flat thereon, attention is directed to the Zepell reference, which discloses another retractable writing instrument wherein a flat 57 is formed on the cartridge in order to aide in assembling the device and guiding the cartridge. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such a flat onto the cartridge in the Waldinger device in order to aide in assembling the device and guiding the cartridge.


Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
8/1/06